

III. REMARKS

In the Office Action, claims 20-22 and 42 were rejected under 35 U.S.C. 112 as being indefinite for reasons set forth in the Office Action. The claims are amended to clarify the indefinite passages so as to overcome this ground of rejection.

Claims 10-11, 18-19, 21-22, 27, 31, 35 and 39 were said to have allowable subject matter, and would be allowed upon overcoming the foregoing rejection under 35 U.S.C. 112.

Also claims 41-42 were said to have allowable subject matter, and would be allowed in independent form and upon overcoming the foregoing rejection under 35 U.S.C. 112.

Claims 1, 7-9, 12-13, 20, 23-26, 29-30, 33-34, and 37-38 were rejected under 35 U.S.C. 103 as being unpatentable over Mizikovsky (US 5,559,860) in view of Kang (US 5,058,150) in Point 10 of the Action, and over Mizikovsky by itself in Point 15 of the Action, and over Mizikovsky in view of Wang (US 5,649,289) in Point 20 of the Action.

Other ones of the claims were also rejected under 35 U.S.C. 103 as being unpatentable over Mizikovsky and Kang in various combinations with other ones of the cited art, namely, claims 2 and 6 over Jambhekar (US 5,848,356), claims 3-5, 28, 32, 36, 40 over Bremer (US 6,018,671), claim 14 over Villa-Real (US 4,481,382), and claims 15-17 over Wolff (US 5,327,486) for reasons set forth in the Action.

Also, various ones of the claims were also rejected under 35 U.S.C. 103 as being unpatentable over Mizikovsky, in various combinations with other ones of the cited art, namely, claims 2 and 6 over Jambhekar, claims 3-5, 28, 32, 36 and 40 over Bremer, claim 14 over Villa-Real, and claims 15-17 over Wolff.

Other ones of the claims were also rejected under 35 U.S.C. 103 as being unpatentable over Mizikovsky and Wang in various combinations with other ones of the cited art, namely, claims 2 and 6 over Jambhekar, claims 3-5, 28, 32, 36 and 40 over Bremer, claim 14 over Villa-Real, and claims 15-17 over Wolff for reasons set forth in the Action.

With respect to the rejections under 35 U.S.C. 103, various ones of the claims are amended and the following argument is presented to distinguish the claimed subject matter from the teachings of the cited art, considered individually and in combination, thereby to overcome the rejections and to show the presence of allowable subject matter in the claims.

The claims, as amended, emphasize an embodiment wherein, when an incoming call occurs, the portable terminal first alerts the user (i.e. informs the user about who is calling and possibly also what alternatives exist for sending a response) and then, according to a selection command that the user gives after having seen the information, sends the selected response. An example of operation in accordance with this particular embodiment is the procedure of silently alerting the user when he or she is at a meeting, and offering to send a quick one-punch response SMS saying "I'm at a meeting, call me later." As an alternative concept you may think of this embodiment as noting that someone is calling, but deciding not to pick up the phone but to answer by some other means that the portable terminal itself offers.

It is argued again that the combination of Mizikovsky and Kang do not pertain to the claimed subject matter. This applies also to the rejections based solely on Mizikovsky (Point 15 of the Action) and the rejections based on the combination of Mizikovsky and Wang (Point 20 of the Action). With respect to the combination of Mizikovsky and Kang, it is urged that neither discloses any portable terminal that would also include functions other than pure telephony. The Examiner has pointed at block 50 of Mizikovsky and cited the case law decision *In re Larson* 144 U.S.P.Q 347, apparently meaning that the accessory devices of block 50 would be rigidly secured together with Mizikovsky's portable terminal. The applicant disagrees. Mizikovsky calls these devices accessories, which as such does not say anything about any rigid connection. For example, at the time when Mizikovsky was published, a telephone answering machine or voice mail were still just standalone devices implemented either as a separate, cable-connected box on the desktop or even remotely in a telephone exchange. The Examiner should

not cite the case law decision as if it somehow proved that Mizikovsky's accessory devices are rigidly secured to the telephone, because it does not.

In any case, even if one were to imagine an experiment of having Mizikovsky's accessory devices or Kang's telephone answering machine fully integrated in a portable terminal, this would still constitute only means of making the apparatus say something on the phone when the user does not say anything himself at the moment. In other words, what the experiment might produce would be just devices that are capable of providing some other information content than live speech during an ongoing telephone conversation. A significant difference exists with respect to the applicant's claimed invention, namely a response "selectable from a plurality of forms of communication" which allows the selected response to be of the out-of-band form, including but not being limited to sending a text message, a fax, or an e-mail. Kang and Mizikovsky deal only with conveying (natural or synthesized) speech in a telephone connection; this is only one form of communication.

By way of further distinction of Kang and Mizikovsky from the concepts of the claimed subject matter, the novel formulation of the present independent claims is that they always require the response mode to have been selected beforehand. When the call comes, the user does not have any more chance to select, what should be done; the telephone will handle the incoming call automatically in accordance with those selections that the user has made at the programming stage. In the invention as now claimed, the incoming call causes the portable terminal to prompt the user and inform about who is calling, in which case the user can still decide, even on the fly, who should deserve which response.

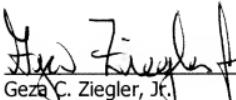
Concerning this last viewpoint, the Examiner has referred to Bremer (US 6,018,671). Here again, it is noted that Bremer has only considered responding to a call by opening the telephone connection, if only in an inactive state in which the speech signals are not flowing at the moment. In other words, also Bremer fails to notice that in sending a response to an incoming call, a plurality of different forms of communication could be

utilized. Mizikovsky, Kang, and Bremer are very much in conformity with each other in thinking that if a telephone call comes, it must be responded to with something that involves activating the telephone connection - or the call must be diverted to a completely different peripheral device, as found in the rightmost part of Mizikovsky's Fig. 1. This is in clear contrast with the applicant's invention as claimed, in which the portable terminal is capable of selecting among a number of forms of communication, all within the capability of the portable terminal alone, and all triggered by the selection made by the user after he or she sees that a call would be coming.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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Date

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